



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/643,294	08/22/2000	Kartikeya P. Pathak	16693-2	8366

7590 12/04/2003

Clifford W Browning
Woodard Emhardt Naughton Moriarty McNett
Bank One Center Tower
111 Monument Circle Suite 3700
Indianapolis, IN 46204

EXAMINER

ROBERT, EDUARDO C

ART UNIT	PAPER NUMBER
----------	--------------

3732

DATE MAILED: 12/04/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/643,294

Applicant(s)

PATHAK, KARTIKEYA P.

Examiner

Eduardo C. Robert

Art Unit

3732

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 April 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 13-24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 13-24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 08 April 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
- a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

Art Unit: 3732

DETAILED ACTION

Drawings

The proposed drawing correction and/or the proposed substitute sheets of drawings, filed on April 8, 2002 have been approved.

Specification

The abstract of the disclosure is objected to because it contains "means", it using phrases which can be implied, e.g. "An improved", and it is not "a" separate sheet within the range of 50 to 150 words. Correction is required. See MPEP § 608.01(b).

Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

The amendment filed on April 8, 2002 is objected to under 35 U.S.C. 132 because it introduces new matter into the disclosure. 35 U.S.C. 132 states that no amendment shall

Art Unit: 3732

introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows:

In page 2, line 10, "plant biology" is new matter.

In page 9, line 13, through page 10, line 4, is new matter.

In page 10, line 7-8, "with self-cutting capabilityexpedient" is new matter. Also, in lines 10-13, "has no chance of catching either smoothly" is new matter. In lines 14-17, "which is capable of ... bone surface" is new matter. In lines 18-20, "to be fixed in a desired position ... rod" is new matter. In lines 21-22, "The head 4 ... turning" is new matter.

In page 11, lines 2-8, "It also serves for ... countersink" is new matter. In line 10, "or faceted" is new matter. In lines 13-21, "Since a lag screw a tap" is new matter.

In page 12, line 2, through page 13, line 21, "A higher load will the rod" is new matter.

In page 14, line 6, "The compression ... off" is new matter. Also, in lines 6-8, "Sliding of screw ... the part" is new matter.

In page 14, line 20, through page 15, line 7, "In the event ... to unite" is new matter.

In page 16, lines 1-2, "with spherical heads ... contact" is new matter. In line 6 through page 17, line 11, "FIG 8 is one type ... phenomenon" is new matter.

Also, Figures 3, 7, 8-12 are considered new matter.

It is noted that the new matter is not supported by the disclosure as originally filed and it is so much that an example of a new matter will be discussed, however, applicant is required to cancel the new matter or explain from where in the original disclosure it is coming.. An example

Art Unit: 3732

follows, the disclosure or drawing or claims as originally filed do not disclose new Figures 8-12 or the description of the figures.

Applicant is required to cancel the new matter in the reply to this Office Action.

Claim Rejections - 35 USC § 112

Claims 13-24 rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

In claim 13, that the “rim at base” is blunt or that the “wavy margin” is blunt, this is new matter. It is noted that Figure C of page 2 as original filed shows a wavy margin or rim, wherein it is not clear if the peaks are blunt or not, e.g. corner peaks appears sharp.

In claims 15 and 16, that the basal rim is blunt beaded is new matter. The original disclosure as filed does not disclose “blunt beaded”.

Claim 21 is new matter because the disclosure as originally filed does not suggest an implant with an intercalated hollow dome shape head with an open base with convexity or apex away from the first end, and having a blunt rim at base and the presence of a blunt wavy margin of the rim (as is required in claim 13), and also the intercalated head is spherical for a concentric and broad contact with a matching countersunk bone surface. Thus, this combination of elements is considered new matter because it was not disclosed as originally filed.

Claims 23 and 24 have similar problems to the one of claim 21.

Art Unit: 3732

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 15, 16, 19, 20-24 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 15, line 1, "said basal rim" lacks a prior antecedent. Also, in lines 1 and 2, "instead of wavy" is indefinite because it is contradicting what claim 13 requires and claim 15 depends from 13 thus it has to include all the limitations of the parent claim.

Claim 16 the same problem as claim 15.

Claim 21 includes the limitations of claim 13 which is directed to the embodiment of Figure 3 but claim 21 appear to be directed to the embodiment of Figure 1, and there is no disclosure of a combination of the these two embodiments.

Claims 23 and 24 have similar problems as claim 21.

Claim Objections

Claim 13 is objected to because of the following informalities:

In claim 13, line 1, "improved" should be deleted. Appropriate correction is required.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

Art Unit: 3732

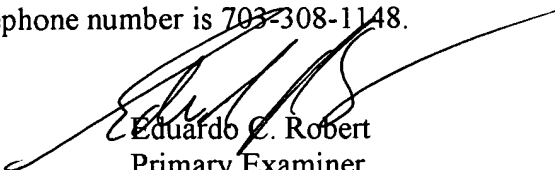
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. See PTO-892 for art of interest.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Eduardo C. Robert whose telephone number is 703-305-7333. The examiner can normally be reached on Monday-Friday, 9:30am-6:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kevin P. Shaver can be reached on 703-308-2582. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1148.



Eduardo C. Robert
Primary Examiner
Art Unit 3732

E.C.R.